

R E M A R K S

- Claims **60 and 70-96** were pending in the present application
- Claim **60** stands rejected
- Claims **70-96** have not been examined

Upon entry of this amendment, which is respectfully requested for the reasons set forth below:

- Claims **60 and 70-121** will be pending
- Claims **97-121** will be added
- Claims **60, 70-73 and 93-96** will be the only independent claims

Telephone Interview

Applicants would like to thank the Examiner for the helpful telephone conversations held on August 3, 2002 and August 5, 2002 with Applicants' representative.

The Examiner clarified that Claim **60** is rejected under 35 U.S.C. 102(a) [not 35 U.S.C. 102(b), as indicated on page 4 of the Office Action] as being clearly anticipated via "Official Notice."

The Examiner and Applicants' representative discussed how pending Claims **70-96** were added in a Preliminary Amendment filed on February 4, 2002, prior to any substantive examination of any claims. The Examiner and Applicants' representative agreed that none of pending Claims **70-96** have yet been examined, and that no search had yet been performed for Claims **70-96**. Accordingly, the Examiner and Applicants' representative agreed that any subsequent Office Action would be non-final.

Applicants' representative suggested the Section 102(a) rejection of Claim **60** "via 'Official Notice'" is an improper use of Official Notice. Applicants' representative suggested that (i) Officially-Noticed facts should not be the principal evidence upon which a rejection is based, (ii) it is never appropriate to rely solely on 'basic knowledge' in the art or 'common sense,' without evidentiary support in the record, as the basis for core factual findings underlying a patentability rejection, and (iii) findings of 'basic knowledge' or 'common sense' in the art may only be used to support peripheral issues. The Examiner disagreed, and stated that the suggestions (i)-(iii) are not always true.

Applicants' representative submitted that suggestions (i)-(iii) were made in light of statements at page 6 of "Administrative Notice Guidelines," Anton Fetting, Legal Advisor, Office of Patent Legal Administration, a copy of which is attached.

While no formal agreement was reached with respect to patentability, Applicants are grateful for the opportunity to discuss the present application with the Examiner.

Claim Amendments

Claims **97-121** have been added, each of which is dependent from Claim **60**. Claims **60, 70-73 and 93-96** are the only independent claims. No new matter has been added.

Claims **60 and 70-121** are consonant with the subject matter (Examiner's Invention XV) elected in light of the Examiner's Restriction Requirement mailed November 20, 2001 (Paper No. 5).

Section 112 Rejection of Claim 60

Claim **60** stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants respectfully traverse this assertion.

1. Obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location

The Examiner asserts that the feature of *obtaining an indication from a credit provider of a line of credit that has been established for a customer who is expected to arrive at a particular location* is unclear. Applicants respectfully traverse this assertion.

i. An indication

The Examiner asks: "What is an indication? How does this differ from an approval?" With respect to the Examiner's suggestion of "an approval," the focus during examination of claims for compliance with the requirement for definiteness of 35 U.S. C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. MPEP § 2173.02.

The essential inquiry pertaining to the requirement of definiteness of claim language of 35 U.S.C. 112, second paragraph, is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made. MPEP § 2173.02.

Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *obtaining an indication from a credit provider of a line of credit that has been established* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity.

The particular subject matter of an indication from a credit provider of a line of credit that has been established may be embodied in various ways. For example, as described in the Specification, according to various embodiments of the present invention, "[i]f the issuing bank approves a credit line, a plastic credit card is shipped to the hotel..." Specification, page 9, lines 18-19. According to one or more embodiments of the present invention:

If RCRS 100 does not receive an acknowledgment [Step 540] with an authorized credit line from CEIS 190, or if CEIS 190 denies all credit for the customer, the process is terminated. [Step 545] If RCRS 100 receives a response from CEIS 190 with an authorized credit line, the sponsoring organization then waits for receipt of the inactive credit card.

Specification, page 14, lines 18-22. According to one or more embodiments of the present invention, “the sponsoring organization receives inactive credit cards from the issuing bank for each approved customer.” Specification, page 15, line 22 to page 16, line 1. According to one or more embodiments of the present invention, “CEIS 190...transmits a notification of the authorized credit line to RCRS 100 of the sponsoring organization.” Specification, page 17, lines 18-20. According to one or more embodiments of the present invention, “the credit card may serve as an indicator to the sponsoring organization that the issuing bank has agreed to provide credit to the customer.” Specification, page 18, lines 12-14. Other embodiments of the claimed feature of *an indication from a credit provider of a line of credit that has been established* are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

ii. Established

The Examiner asks: “What is the legal significance [sic] of established?” The Examiner further asserts: “While the applicant is free to select claims language, it should conform [sic] the industry standards (i.e., U.S. Consumer Credit Acts).” Applicants respectfully traverse this assertion.

The particular subject matter of a line of credit that has been established may be embodied in various ways. For example, according to one or more embodiments of the present invention, “CEIS 190 creates an inactive customer account in credit account database 400 with an authorization of credit [Step 640]....” Specification, page 18, lines 10-11. According to one or more embodiments of the present invention, “CEIS 190 then increases the authorized credit line by the amount of the guarantee [Step 636] and records the amount of credit guaranteed by the sponsoring organization in credit account database 400.” Specification, page 18, lines 6-9. Other embodiments that provide for the claimed subject matter of *a line of credit that has been established* are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *a line of credit that has been established* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity.

a. “Legal significance”

Applicants respectfully traverse any implication that the claimed feature of *a line of credit that has been established* need have any “legal significance.” Further, Applicants are not aware of any requirement by which the “legal significance” of a claimed feature must be recited. Applicants respectfully request that the Examiner provide a citation to an authority indicating a requirement that the “legal significance” of a claimed feature must be recited. As discussed above, the particular subject matter is set out with a reasonable degree of clarity and particularity.

b. Conformance to “industry standards”

Applicants are not aware of any requirement by which all claimed features must conform to “industry standards.” For example, even if the claimed feature of *a line of credit that has been established* does not conform to an industry standard, an assertion that Applicants dispute, Applicants need not confine themselves to the terminology used in the prior art. See MPEP §

2173.05(a). Further, courts have recognized that it is not only permissible, but often desirable, to use new terms that are frequently more precise in describing and defining the new invention. See MPEP § 2173.05(a).

Beyond the brief reference to the “U.S. Consumer Credit Acts,” the Examiner does not provide any indication of the asserted “industry standards.” Accordingly, Applicants respectfully dispute the Examiner’s assertion that the claimed feature does not conform to “industry standards.”

So that Applicants may best assist the Examiner in the examination of the present application, Applicants respectfully request that the Examiner provide (i) a specific reference to the “U.S. Consumer Credit Acts” that indicates “the industry standards,” (ii) a reasoned explanation of how the claimed feature of *a line of credit that has been established* does not conform to “the industry standards,” and (iii) a reasoned explanation of how any asserted failure to conform to “the industry standards” results in an unreasonable degree of clarity and particularity.

iii. Credit line

The Examiner asserts: “‘credit line’ is unclear.” Applicants respectfully traverse this assertion.

According to some embodiments of the present invention, a line of credit is established, as discussed above. The line of credit, may be, but need not be, associated with a credit card account. According to various embodiments of the present invention, the credit provider is a credit card issuer, but in one or more embodiments “can be any qualified lending institution.” Specification, page 9, lines 13-15. According to one or more embodiments of the present invention, “CEIS 190 creates an inactive customer account in credit account database 400 with an authorization of credit [Step 640]....” Specification, page 18, lines 10-11. Other embodiments that provide for the claimed feature of *a line of credit* are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *a line of credit* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity.

iv. A customer who is expected to arrive at a particular location

The Examiner asserts: “‘expected to arrive at a particular location’... fails to convey with the necessary certainty what the Applicant regards as his invention. The boundaries of the invention are unreasonably vague [sic] (i.e., expected (by whom? using wha [sic] standard? or ‘particular location’ (defined by whom? how particular?)).” Applicants respectfully traverse these assertions.

Applicants respectfully submit that the scope of the claimed subject matter may be broad, but is not vague, much less “unreasonably vague.” Breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP § 2173.04.

Further, Applicants respectfully submit that the claimed feature of *a customer who is expected to arrive at a particular location* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity.

For example, according to some embodiments of the present invention:

The operation of the system...may apply to any merchant, organization or service provider able to identify the anticipated arrival of potential customers, members or patrons.... Generally, the sponsoring organization may be any organization with whom potential customers typically make advance reservations...or any organization with whom members, patrons or customers typically register in advance for attendance at an event.... In further embodiments of the invention, the sponsoring organization can include any merchant or service provider who can anticipate the arrival of a customer at a particular location, for example, (a) a customer who comes to a retail location on a periodic basis, (b) a customer who drops off goods with a merchant...for later pick up, and (c) a customer who has scheduled a service....

Specification, page 8, line 20 to page 9, line 12. In another example, according to one or more embodiments of the present invention: "When a customer makes a reservation at a hotel, the hotel requests a credit card on the customer's behalf." Specification, page 9, lines 17-18. In another example, according to one or more embodiments of the present invention, "the hotel identifies an expected customer by receiving a reservation from him." Specification, page 13, lines 10-11. Other embodiments that provide for the claimed feature of *a customer who is expected to arrive at a particular location* are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

Thus, Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *a customer who is expected to arrive at a particular location* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity

2. Offering said credit line to said customer while said customer is at said location

The Examiner asserts: "'while said customer is at said location'...fails to convey with the necessary certainty what the Applicant regards as his invention." Applicants respectfully traverse this assertion.

The Examiner does not provide any reasoning as to why one having ordinary skill in the art would not be able to determine the scope of the claimed subject matter with a reasonable degree of certainty. Applicants respectfully request that the Examiner provide any such reasons in support of the Examiner's assertion that the claimed feature of *while said customer is at said location* is not sufficiently certain.

Further, Applicants respectfully submit that the claimed feature of *then offering said credit line to said customer while said customer is at said location* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity. For example, according to some embodiments of the present invention, "the hotel offers the card to the customer upon check-in, or at any time during the customer's stay at the hotel." Specification, page 9, lines 18-20. Other embodiments that provide for the claimed feature of *then offering*

said credit line to said customer while said customer is at said location are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

Thus, Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *then offering said credit line to said customer while said customer is at said location* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity

3. Chargeable event

The Examiner asserts that “the limitation ‘chargeable event’ is lack [sic] specificity.” Applicants respectfully traverse this assertion.

The Examiner does not provide any reasoning as to why one having ordinary skill in the art would not be able to determine the scope of *a chargeable event* with a reasonable degree of certainty. Applicants respectfully request that the Examiner provide any such reasons in support of the Examiner’s assertion that the claimed feature of *a chargeable event* is not reasonably clear and particular.

Applicants also respectfully submit that a claimed feature need not be “specific,” but only reasonably clear and particular. Breadth of a claim is not to be equated with indefiniteness. If the scope of the subject matter embraced by the claims is clear, and if applicants have not otherwise indicated that they intend the invention to be of a scope different from that defined in the claims, then the claims comply with 35 U.S.C. 112, second paragraph. MPEP § 2173.04.

Further, Applicants respectfully submit that the claimed feature of *a chargeable event* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity for one having ordinary skill in the art. For example, as is well known in the art, purchases and cash advances may be charged to a credit card. See, e.g., Specification, page 1, lines 12-14. In another example, according to various embodiments of the present invention, “the customer may be encouraged to use the new credit card to pay for the current visit to the hotel, thereby creating an immediate charge to the account....” Specification, page 17, lines 5-7. Other embodiments that provide for the claimed feature of *a chargeable event* are described in the Specification, and other embodiments will be apparent to those having ordinary skill in the art.

Thus, Applicants respectfully submit that in light of the Specification, the teachings of the prior art, and the ordinary level of skill in the pertinent art at the time the invention was made, the claimed feature of *a chargeable event* sets out and circumscribes the particular subject matter with a reasonable degree of clarity and particularity

Section 102(a) Rejection

Claim 60 stands rejected under 35 U.S.C. 102(a) as being “clearly anticipated via ‘Official Notice.’” Applicants respectfully traverse any rejection by the Examiner under Section 102.

1. Improper use of “Official Notice” as sole evidence for rejection

Claim 60 is rejected solely in light of an Officially-Noticed “business method.” The Examiner does not provide documentary evidence in support of the Official Notice. Accordingly, Applicants respectfully submit that the Section 102(a) rejection of Claim 60 “via ‘Official Notice’” is an improper use of Official Notice.

“The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being ‘well-known’ in the art.” MPEP 2144.03. However, “the facts so noticed serve to ‘fill in the gaps’ which might exist in the evidentiary showing” and should not comprise the principle evidence upon which a rejection is based. MPEP 2144.03 (citing *In re Ahlert*, 424 F.2d 1088, 1091) (emphasis added).

Applicants respectfully submit that (i) Officially-Noticed facts should not be the principal evidence upon which a rejection is based; (ii) it is never appropriate to rely solely on ‘basic knowledge’ in the art or ‘common sense,’ without evidentiary support in the record, as the basis for core factual findings underlying a patentability rejection; and (iii) findings of ‘basic knowledge’ or ‘common sense’ in the art may only be used to support peripheral issues. See, “Administrative Notice Guidelines,” Anton Fetting, Legal Advisor, Office of Patent Legal Administration, U.S. Patent and Trademark Office, page 6 (copy attached).

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of Claim 60.

2. Traversal of Official Notice of asserted “business method”

Given that the only particular information in the record thus far regarding what is considered to be in the prior art is the brief statement of the asserted “business method,” Applicants cannot properly determine the bounds of the prior art. Accordingly, Applicants dispute that the subject matter asserted was “well known” at the time the invention was made, and request a reference to clarify the subject matter in more detail. MPEP 2144.03.

3. The Officially-Noticed “business method” does not teach or suggest all of the features of independent Claim 60

Even if the sole use of the Officially-Noticed “business method” without any documentary evidence is proper, which Applicants dispute, Applicants respectfully submit that Claim 60 is not anticipated by the asserted “business method.”

No teaching or suggestion of *obtaining an indication from a credit provider of a line of credit that has been established for a customer*

The asserted “business method” does not teach or suggest *obtaining an indication from a credit provider of a line of credit that has been established for a customer...then offering said credit line to said customer while said customer is at said location.*

The asserted “business method” describes a credit card that is “preapproved,” issued, and mailed to an “approved” home, and a call by an “approved” to a credit card company to activate the credit card, in which the “approved” is charged an activation fee.

Without documentary evidence, it is not clear to Applicants whether the “preapproved credit card,” as stated in the asserted “business method,” means a credit card that is not yet approved, a credit card that has already been approved, or some other type of credit card.

Further, there is nothing in the asserted “business method” to suggest that the “preapproved credit card” suggests an indication that a line of credit has been established for a customer. Thus, Applicants respectfully submit that the asserted “business method” does not teach or suggest the feature of *a line of credit that has been established for a customer*, much less *obtaining an indication from a credit provider of a line of credit that has been established for a customer*, as recited in independent Claim 60.

Accordingly, Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation of independent Claim 60.

Newly-Added Claims 97-121

Each of newly-added Claims 97-121 is dependent from independent Claim 60. For at least the reasons stated above with respect to independent Claim 60, Applicants respectfully submit that each of Claims 97-121 contains allowable subject matter.

Conclusion

The Examiner's early examination and consideration are respectfully requested.

If there remains any question regarding the present application, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Michael Downs at telephone number (203) 461-7292 or via electronic mail at mdowns@walkerdigital.com.

Please charge any fees that may be required for this Amendment to Deposit Account No. 50-0271. Furthermore, should an extension of time be required, please grant any extension of time which may be required to make this Amendment timely, and please charge any fee for such an extension to Deposit Account No. 50-0271.

Petition for Extension of Time to Respond

Applicants hereby petition for a Two-month extension of time with which to respond to the Office Action. Please charge \$200.00 for this petition to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an additional extension of time is required, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,



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August 29, 2002
Date